

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 112

Claims 1, 8 and 9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

With respect to claim 1, the Examiner contends the term "them" lacks sufficient antecedent basis. Claim 1, as amended, replaces the term "them" with the phrase "the one or more encoded ad properties" to ensure proper

antecedent basis. Independent claim 20 was similarly amended. Thus, the applicants respectfully submit that claim 1 (and similarly claim 20), as amended, meets the requirements of 35 U.S.C. § 112, second paragraph.

Claims 8 and 9 were rejected for grammatical reasons. Claims 8 and 9 were amended based on the Examiner's helpful suggestion. Claims 17, 18, 27, 28, 36 and 37 were similarly amended. Thus, the applicants respectfully submit that claims 8 and 9 (and similarly claims 17, 18, 27, 28, 36 and 37), as amended, meet the requirements of 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 102

Claims 1 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by purported "Applicant's admitted prior art" and by U.S. Patent Application Publication No. 2002/0010757 ("the Granik publication"). Claims 2, 3, 21 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Granik publication. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 1 and 20 have been amended to clearly indicate that **the one or more encoded ad properties include at least one of (1) information indicating how the ad was served, (2) information indicating advertiser charges, and (3) information indicating how the ad was selected as a candidate for serving.** This amendment is supported by claims 3 and 22 as originally filed.

The foregoing amendment to claims 1 and 20 further distinguishes the claimed invention from the purported "Applicant's admitted prior art" cited by the Examiner. The background information provided on page 3 of the present application, cited by the Examiner, does not describe **encoding or decoding** one or more ad properties included in a click URL **wherein the one or more encoded ad properties include at least one of (1) information indicating how the ad was served, (2) information indicating advertiser charges, and (3) information indicating how the ad was selected triggered**, as recited in amended claims 1 and 20. Thus, claims 1 and 20, as amended, are not anticipated by the purported "Applicant's admitted prior art" cited by the Examiner for at least this reason.

Further, the discussion in the "Background Information" section of the application is not "admitted prior art," since it was never identified as "prior art." (See MPEP 2129.)

In addition, the foregoing amendments to claims 1 and 20 further distinguish the claimed invention over the Granik publication cited by the Examiner as teaching the features of original claims 1 and 20. Specifically, the portion of the Granik publication cited by the Examiner provides:

Particularly, in response to a user click on a replaced ad, a web-based communication 32 is generated that includes a re-direct ad URL including: 1) an encrypted identifier that identifies the user on the re-direct server; and 2) an ultimate destination website code.

(Paragraph [0043] of the Granik publication) However, the encrypted identifier that identifies a user, and the ultimate destination website code, which are included in the re-direct ad URL in the Granik publication do not teach encoding or decoding one or more ad properties included in a click URL **wherein the one or more encoded ad properties include at least one of (1) information indicating how the ad was served, (2) information indicating advertiser charges, and (3) information indicating how the ad was selected triggered** as recited in amended claims 1 and 20.

Thus, claims 1 and 20, as amended, are not anticipated by the Granik publication for at least this reason. Since claims 2 and 3 depend from claim 1, and since claims 21 and 22 depend from claim 20, these claims are similarly not anticipated by the Granik publication.

Thus, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-3 and 20-22 for at least the foregoing reasons.

Rejections under 35 U.S.C. § 103

Claims 4-9 and 23-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik publication in view of the paper, T. Berners-Lee, et al, "Uniform Resource Identifiers (URI): General Syntax," Network Working Group, Request for Comments: 2396, (August 1998) ("RFC 2396"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 4-9 and 23-28 directly or indirectly depend from claims 1 and 20, respectively. The purported teachings of RFC 2396 would not compensate for the deficiencies of the Granik publication with respect to claims 1 and 20, as amended (discussed above), regardless of the scope of the purported disclosure in RFC 2396, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 4-9 and 23-28 are not rendered obvious by the cited references for at least this reason.

Claims 10-12, 19, 29-31 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik publication in view of U.S. Patent Application Publication No. 2003/0035139 ("the Tomita publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, one skilled in the art would not have combined the Granik and Tomita publications as proposed by the Examiner. The Granik publication generally concerns "an Internet/world-wide-web-based advertisement replacement system and methodology for **replacing advertising content on web-based communications received by users**. [Emphasis added.]" (Abstract of the Granik publication) Specifically, paragraph [0043] of the Granik publication, cited by the Examiner, states:

Particularly, in response to a user click on a replaced ad, a web-based communication 32 is generated that includes a re-direct ad URL including: 1) an encrypted identifier that identifies the user on the re-

direct server; and 2) an ultimate destination website code.

By contrast, paragraph [0213] of the Tomita publication, cited by the Examiner, provides:

When the CPU 201 judges that firmware is attached (step S126, Yes), it extracts the part in the body section that corresponds to the firmware (step S127). As has been described, the data of the firmware has been converted to US-ASCII code according to Base 64 conversion in order to be attached to the e-mail. Therefore, the CPU 201 converts the character string back to binary data according to reverse Base64 conversion (step S128), and then stores the resulting binary data in the hard disk drive 205 (step S129).

The Tomita publication is discussing a system and method of ***implementing firmware updates in coordination with image processing jobs in an image processing apparatus.***

Firmware data is "converted to US-ASCII code according to Base 64 conversion" and sent via e-mail to the image processing apparatus which then converts it back to binary data. (See Abstract and paragraphs [0018] and [0213] of the Tomita publication.)

Neither the Granik publication, nor the Tomita publication, contains any teaching, suggestion, or motivation (nor is there any obvious reason) to combine these disparate references as proposed by the Examiner to produce the claimed invention. That is, one skilled in the art would not have combined a system ***for replacing advertising content on web-based communications received by users*** with a system ***for implementing firmware updates***

in coordination with image processing jobs in an image processing apparatus. Consequently, claims 10 and 29 are not rendered obvious by the cited references for at least this first reason.

Second, regardless of the absence or presence of motivation to combine, claims 10 and 29 are not rendered obvious by the Granik and Tomita publications because the cited references do not teach, or suggest, the acts of (or means for) (a) representing each of one or more ad properties of an ad with a binary value, (b) concatenating each of the one or more binary values to define a sequence of bits, (c) encoding the sequence of bits into a sequence of characters, wherein each of the characters is selected from a set of K legal characters, and (d) providing the sequence of characters in a click URL of the ad.

In rejecting claims 10 and 29, the Examiner cites paragraph [0213] of the Tomita publication as teaching that "it is well known to encode binary data and parameters as a string of valid characters" and therefore teaches elements (a) through (c) in claims 10 and 29. (See Paper No. 20071009, page 6.) In addition, the applicants note that, although not explicitly stated, the Examiner is apparently using the purported teachings of the Granik publication as teaching element (d) of claims 10 and 29. The applicants respectfully disagree.

The Tomita publication concerns an image processing apparatus having a printer controller which "receives firmware attached to e-mail from a mail server, downloads the firmware to an internal hard disk drive, and registers the job at the bottom of a job registration

table." (Abstract of the Tomita publication) Specifically, as discussed above, the portion of the Tomita publication cited by the Examiner provides:

When the CPU 201 judges that firmware is attached (step S126, Yes), it extracts the part in the body section that corresponds to the firmware (step S127). As has been described, the data of the firmware has been converted to US-ASCII code according to Base 64 conversion in order to be attached to the e-mail. Therefore, the CPU 201 converts the character string back to binary data according to reverse Base64 conversion (step S128), and then stores the resulting binary data in the hard disk drive 205 (step S129).

(Paragraph [0213] of the Tomita publication) The Tomita publication is discussing a system and method of implementing firmware updates in an image processing apparatus. Firmware data is "converted to US-ASCII code according to Base 64 conversion" and sent via e-mail to the image processing apparatus which then converts it back to binary data. As can be appreciated from the foregoing, the Tomita publication does not teach or suggest (a) **representing each of one or more ad properties of an ad with a binary value**, (b) concatenating each of the one or more binary values to define a sequence of bits, and (c) encoding the sequence of bits into a sequence of characters, wherein each of the characters is selected from a set of K legal characters. The Tomita publication merely converts firmware data into "US-ASCII code according to Base 64 conversion in order to be attached to the e-mail."

(Paragraph [0213] of the Tomita publication) The Tomita publication has nothing to do with representing ad properties of an ad in binary value. Furthermore, the purported teachings of the Granik publication fail to compensate for the deficiencies of the Tomita publication discussed above.

Thus, claims 10 and 29 are not rendered obvious by the Tomita publication and the Granik publication for at least this second reason. Since claims 11, 12 and 19 depend from claim 10, and since claims 30, 31 and 38 depend from claim 29, these claims are similarly not rendered obvious by the cited references.

Claims 13-18 and 32-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik publication, in view of the Tomita publication and RFC 2396. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 13-18 and 32-37 depend, either directly or indirectly, from claims 10 and 29, respectively. The purported teachings of the RFC 2396 would not compensate for the deficiencies of the Granik and Tomita publications with respect to claims 10 and 29 (discussed above), regardless of the scope of the purported disclosure in RFC 2396, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 13-18 and 32-37 are not rendered obvious by the cited references for at least this reason.

New Claims

New dependent claims 39 and 40 depend from independent claim 1 and are patentable over the cited art for at least the reasons discussed above with respect to claim 1. The subject matter recited in new claims 39 and 40 is supported by claim 3 as originally filed.

New dependent claims 41 and 42 depend from independent claim 20 and are patentable over the cited art for at least the reasons discussed above with respect to claim 20. The subject matter recited in new claims 41 and 42 are supported by claim 22 as originally filed.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Respectfully submitted,

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